

## **REMARKS / ARGUMENTS**

### **I. General Remarks and Remarks Regarding Restriction Requirement**

Claims 1-23 are pending. Claim 1 has been amended to correct a typographical error. Applicants respectfully request that the above amendments be entered, and further request reconsideration in light of the amendments and remarks contained herein.

On October 27, 2005, during a telephone conversation with the Examiner, claims 1-23 were provisionally elected in response to the Examiner's restriction requirement without traverse. This provisional election is hereby confirmed, and claims 24-48 have been cancelled. No amendment to inventorship is necessitated by this election. Applicants reserve their rights to subsequently take up prosecution on the claims as originally filed in this or an appropriate continuing application.

### **II. Remarks Regarding the 35 U.S.C. § 102(b) Rejection**

Claims 1-3, 5-16, 18-20 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,820,670 issued to Chatterji *et al.* (hereinafter “*Chatterji*”). With respect to these claims and *Chatterji*, the Examiner states:

US 5,820,670 discloses a method that includes a method of cementing in a subterranean formation comprising the steps of: providing a cement composition comprising a unhydrated cement that comprises a high alumina cement, a silica source (fly ash), and a soluble phosphate; and a set retarder comprising a water soluble carboxylic acid (tartaric acid); placing the cement composition into the subterranean formation; permitting the cement composition to set therein. With respect to the depending claims, the reference teaches the limitations as claimed, including rubber particles and carbon fibers.

(Office Action, at page 4.) Applicants respectfully disagree.

In order to form a basis for a § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. See MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004) (hereinafter “MPEP”). Applicants submit that *Chatterji* does not anticipate the rejected claims, because it does not teach each and every element set forth in the claims. In particular, as to claim 1, *Chatterji* fails to teach a method wherein the cement composition comprises “an unhydrated cement.” Rather, the cement composition in *Chatterji* is comprised of “sufficient water to form a pumpable slurry.” (*Chatterji*, col. 6, lines 50-62.)

Therefore, as the cement composition in *Chatterji* is hydrated, it cannot anticipate Applicants' claims.

Accordingly, *Chatterji* does not anticipate Applicants' claims. Moreover, since "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers," and since claims 2-3, 5-16, 18-20 and 22 depend from claim 1, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicant respectfully requests the withdrawal of the § 102(b) rejections as to claims 1-3, 5-16, 18-20 and 22, and further request the timely issuance of a Notice of Allowance for these claims.

### **III. Remarks Regarding the 35 U.S.C. § 102(e) Rejection**

The Examiner has rejected claims 1-3, 5-15, 19, 20, and 22 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,796,378 issued to Reddy *et al.* (hereinafter "Reddy"). With respect to these claims and *Reddy*, the Examiner states:

US 6,796,378 discloses a method that includes a method of cementing in a subterranean formation comprising the steps of: providing a cement composition comprising a unhydrated cement that comprises a high alumina cement, a silica source (fly ash), and a soluble phosphate; and a set retarder comprising a water soluble carboxylic acid (citric or tartaric acid); placing the cement composition into the subterranean formation; permitting the cement composition to set therein. With respect to the depending claims, the reference teaches the limitations as claimed, including rubber particles.

(Office Action, at page 4.) To anticipate a claim, a reference must teach or suggest each and every claim limitation. MPEP § 2131. *Reddy* does not contain each and every element of the claimed invention, and as such, it cannot anticipate Applicants' claims. In particular, as to claim 1, *Reddy* fails to teach a method wherein the cement composition comprises "an unhydrated cement." Rather, the cement composition in *Reddy* is comprised of "sufficient water to form a pumpable slurry." (*Reddy*, col. 2, lines 40-43.) Therefore, as the cement composition in *Reddy* is hydrated, it cannot anticipate Applicants' claims.

Accordingly, *Reddy* does not anticipate Applicants' claims. Moreover, since "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers," and since claims 2-3, 5-15, 19, 20 and 22 depend from claim 1, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004).

Accordingly, Applicant respectfully requests the withdrawal of the § 102(e) rejections as to claims 1-3, 5-15, 19, 20, and 22, and further request the timely issuance of a Notice of Allowance for these claims.

**IV. Remarks Regarding the Obviousness-Type Double Patenting Rejection.**

Claims 4 and 23 stand rejected under the judicially created doctrine of obviousness-type double patenting as obvious over U.S. Patent 6,904,971 issued to Brothers *et al.* (hereinafter “*Brothers*”) (Office Action, at page 5.) The standard for determining whether the judicially created doctrine of double patenting applies to a claim is the same standard applied in determining whether a claim fails to meet the nonobviousness requirement of 35 U.S.C. § 103, which requires that the cited reference teach or suggest each element in the rejected claim. *See* MPEP §§ 804 & 2142 (2004).

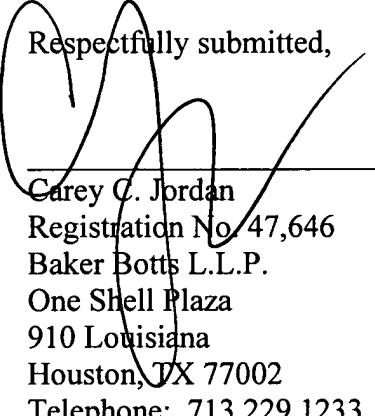
The claims of the present invention include a cement composition that comprises “an unhydrated cement.” An examination of *Brothers* fails to reveal any reference to the use of an unhydrated cement. Rather, the cement composition in *Brothers* is comprised of “sufficient water to form a pumpable slurry.” (*Brothers*, col. 2 lines 30-34). Thus, applicants submit that *Brothers* does not teach or suggest each and every claim limitation, because it fails to teach the use of an unhydrated cement. Thus, Applicants respectfully request withdrawal of the obviousness-type double patenting rejection as to claims 4 and 23.

**SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that no fees are due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.0991, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,

  
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